

REMARKS

Reconsideration of the application is respectfully requested in view of the amendments and the discussion presented below. The amendments are supported by the application as filed and no new matter has been added by any of the amendments.

Claims 1, 2, 20, 22, and 23 are amended, as described further below.

Claims 1-32 are now present in this application. The Examiner has withdrawn claims 6-8, 13-17, and 24-32 from consideration.

Discussion

1. Restriction requirement

The Applicant notes that the restriction requirement is made final and maintains his traversal in order to preserve his right to petition under 37 CFR 1.144.

2. Objection to drawings

The objection to the drawings is respectfully traversed. Figure 3 shows the result of the step in which the coating layer 10 covers the defects 11, 12, and 13. The defects 11, 12, and 13 are shown to be "uniformly covered" as discussed below in connection with the rejection of claim 2 under 35 USC 112, second paragraph. No change to the drawings or claim 2 on this account is believed to be necessary.

3. Objection to claim 20, 22, and 23

The objections to claims 20, 22, and 23 are met by amending these claims as suggested by the Examiner. It is noted that this amendment will conform these claims to the format approved in *Ex parte Markush*, 1925 C.D. 126 (Comm'r Pat. 1925).

4. Rejection of claim 2 under 35 USC 112, second paragraph

The rejection of claim 2 under 35 USC 112, second paragraph, is overcome by amending that claim to recite "protective layer," which clearly has antecedent basis in claim 1.

The Examiner inquired how the layer "uniformly" covers the defects. The specification, at page 5, lines 20-21, teaches that the protective layer should be thick enough to "uniformly cover all

defects.” One definition of “uniform” is “presenting an unvaried appearance of surface, pattern, or color,” Merriam-Webster On-Line Dictionary; *accord*, American Heritage Dictionary of the English Language, Fourth Edition (consulted on-line)(“unvaried in texture, color, or design”). This limitation of claim 2 clearly means that all of the defects are covered and the protective layer will not have the varied appearance that would result if some defects protruded from the protective layer.

5. Rejection of claims 1-3 and 18-20 under 35 USC 102(b) as being anticipated by Fujisada, et al.

Claim 1 is amended to recite that the protective layer is planar. That limitation was originally present in claim 2. Fujisada, et al. (JP 58-18928) does not teach or suggest the step of coating the semiconductor surface and the defects with a planar protective layer as recited in claim 1.

Figure 2(a) of Fujisada, et al. shows that the resist 3 covers the defects with a thinner film than the other portions of the resist 3. The abstract teaches that “[t]he resultant film [of the resist 3] covering the surface of the protrusion is far thinner than other [*sic*] portion of the film.” As a result, the defects 2 protrude above the level of the rest of the resist 3. As may be seen in Figure 2(a) of Fujisada, et al., the resist 3 of Fujisada, et al. is not planar – it is **non-planar** to the point of appearing to be mountainous in miniature.

Claims 2, 3, and 18-20 depend from claim 1 directly or indirectly and are therefore not anticipated by Fujisada, et al. for at least that reason.

6. Rejection of claims 4, 5, and 9-12 under 35 USC 103(a) as being unpatentable over Fujisada et al. in view of Kudo, et al. or Chiu, et al.

The Examiner states that Fujisada, et al. discloses the claimed method with the exception of how the step of thinning is carried out (with regards to claims 9, 11, and 12). The limitations added by claims 9, 11, and 12 are asserted to be taught by Kudo, et al. (JP 63-216346) and Chiu, et al. (US 6,955,177). The claimed thickness of the photoresist layer (claims 4 and 5) and the claimed etch rate (claim 10) of the process used for thinning in claim 9 are said to involve “routine optimization” within the level of ordinary skill in the art.

Claims 4, 5, and 9-12 depend indirectly from claim 1. As explained above, Fujisada, et al. does not teach or suggest the method of claim 1. The Examiner has not asserted that Kudo, et al. or Chiu, et al. teach or suggest the limitations of the method of claim 1. "Routine optimization" with respect to the claimed thickness of the photoresist layer and the claimed etch rate, even if valid, still does not teach or suggest the limitations of the method of claim 1. The suggested combinations and modifications therefore cannot not teach or suggest the limitations of claims 4, 5, and 9-12 and a *prima facie* case of obviousness is not established.

Furthermore, the *prima facie* case of obviousness with respect to claims 9, 11, and 12 is not established because the Examiner has not articulated the basis on which he concludes that it would have been obvious to make the claimed invention using the combination of the Fujisada, et al., Kudo, et al., and Chiu, et al. references. The Examiner merely states that it would have been obvious for one skilled in the art, at the time of the present invention, to modify Fujisada, et al. with Kudo, et al. and Chiu, et al. to produce the claimed methods. He does not identify the suggestion or motivation for combining features of these references. Without an explanation of suggestion or motivation, one can only conclude that the Examiner has employed the claims as his sole guide for combining the references – in other words, hindsight. This is clear error. *See* M.P.E.P. at section 2143.01, *accord In re Rouffet*, 47 USPQ2d 1451, 1457-58 (Fed. Cir. 1998)("[t]o prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness").

Finally, the case law cited with respect to the rejection of claims 4, 5, and 10 deals with claims in which the *only* novelty lay in the specific claimed ratios, ranges or rates and these ratios, ranges or rates were relied on as being the "contribution to the art," *i.e.*, the basis for non-obviousness. *E.g.*, *In re Huang*, 40 U.S.P.Q.2d 1685, 1688-89 (Fed. Cir. 1996)(thickness ratios of polyurethane layer recited in the claims was only difference from the prior art but was held to be within the capabilities of one of ordinary skill in the art without evidence of achievement of unexpected results). In this case, the underlying base claim is directed to novel and nonobvious subject matter. The Applicant is not required to provide proof of "unexpected results" with respect to the limitations added by claims 4, 5, and 10.

For at least these reasons the *prima facie* case of obviousness has not been established and this rejection should be withdrawn.

7. Rejection of claims 21-23 under 35 USC 103(a) as being unpatentable over Fujisada et al. in view of Takehiko, et al. or Starzynski

The Examiner states that Fujisada, et al. "substantially discloses" the claimed method with the exception of how the step of removing the defects is carried out by means of a wet chemical etchant (taught in claims 21-23). The limitations added by claims 21-23 are asserted to be taught by Takehiko, et al. (JP 06041770) or Starrzynski (US 2005/006505).

Claims 21-23 depend directly or indirectly from claim 1. As explained above, Fujisada, et al. do not teach or suggest the claimed method of claim 1. The Examiner has not asserted that Takehiko, et al. or Starzynski teach or suggest the limitations of the method of claim 1. The suggested combinations therefore cannot teach or suggest the limitations of claims 21-23 and a *prima facie* case of obviousness is not established.

Furthermore, the *prima facie* case of obviousness is not established because the Examiner has not identified the suggestion or motivation for combining the features of the Fujisada, et al., Takehiko, et al. or Starzynski references, other than the blueprints provided by claims 21-23. As observed above, this is error and a further reason why the *prima facie* case of obviousness has not been established.

For at least these reasons a *prima facie* case of obviousness has not been established and this rejection should be withdrawn.

Conclusion

In view of the above, the Applicant submits that the application is now in condition for allowance and respectfully urges the Examiner to pass this case to issue. The Examiner is respectfully invited to telephone the undersigned attorney as needed in order to advance the examination of this application.

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The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 12-0415. In particular, if this response is not timely filed, then the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months

necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 12-0415.

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(Date of Transmission)

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April 6, 2006

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Respectfully submitted,

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